

Amendments to the Claims:

1. (Original) A package for mailing items from a merchant to a customer, the package comprising:
 - at least one surface, the surface having a bar code thereon; wherein the bar code identifies the customer.
2. (Original) The package of Claim 1, wherein the bar code includes a complete order and return history for the customer.
3. (Currently amended) The package of Claim 1, wherein the package is marked by the merchant with the return mailing address of the merchandise adapted to be returned from the customer to the merchant via mail.
4. (Original) The package of Claim 1, wherein scanning the bar code enables the merchant to identify items or categories of items in which the customer is interested.
5. (Original) A method of tracking an order and return history of a customer, the method comprising the steps of:
 - providing a package including a bar code that identifies the customer;
 - receiving the package from the customer, the package containing returned items;
 - scanning the bar code to identify the customer;
 - inputting the returned items into an inventory database; and
 - updating the customer's order and return history.
6. (Original) The method of Claim 5, wherein the steps of inputting the returned items into the inventory database and updating the customer's order and return history are performed simultaneously.
7. (Currently amended) A method of targeted advertising, the method comprising the steps of:
 - accumulating information about orders placed by a customer;
 - analyzing the information;
 - predicting, based on the information, what type of items the customer is likely to purchase in the future; and

mailing the customer an item in response to a request by the customer; and
providing the customer with advertising directed toward those items by
mail.

8. (Original) The method of Claim 7, the method further comprising the step of:
providing a package including a bar code that identifies the customer.
9. (Original) The method of Claim 8, the method further comprising the step of:
receiving an order from the customer.
10. (Original) The method of Claim 9, the method further comprising the step of:
scanning the customer's bar code.
11. (Original) The method of Claim 8, wherein the advertising is provided to the
customer in a second package that includes the customer's bar code.
12. (Original) The method of Claim 11, the method further comprising the step of
sending the second package to the customer.
13. (New) The package of Claim 1, wherein the bar code includes information on
orders and returns for the customer.
14. (New) The package of Claim 1, wherein the customer is identified by name.
15. (New) The package of Claim 1, wherein the customer is identified by address.
16. (New) The package of Claim 4, wherein information on at least one item in which
the customer is interested is included in the package.
17. (New) The method of Claim 5, wherein items are returned because the customer
found them unacceptable.
18. (New) The method of Claim 7, wherein the advertising is provided in a mailed
packaging containing an item ordered by the customer.
19. (New) The method of Claim 7, wherein the advertising is selected based at least
in part on the return history of the customer.

Remarks

The Examiner rejected Claims 1-12 on various combinations of references. In view of the following comments and amendments, reconsideration and withdrawal of those rejections is respectfully requested. New dependent Claims 13-18 are added.

Objection To Claim 3:

The Examiner objected to the use of "adapted to" in Claim 3. Per the Examiner's suggestion, the claim is revised to delete "adapted to."

Claims 1-4, § 102 Rejection On Kadaba

The Examiner rejected independent Claim 1 and dependent Claim 4 under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,285,916 to Kadaba, citing Col. 5, line 56-Col. 6, line 9.

Claim 1 requires that "the bar code identifies the customer." Kadaba does not disclose that the package bar code identifies the customer. The portion of Kadaba cited by the Examiner discusses two ways to check in the items. The first way is to scan bar code 30. The second way is to download information to a PDA and that downloading can include the identity of the sender and the recipient. Col. 6, lines 3-4. But the information obtained from the bar code 30 is only the tracking number. Col. 6, lines 10-30.

The tracking number "can be used to access other tracking information stored in the central tracking computer 45." Col. 6, lines 12-14. But even then "the tracking number is associated in the memory 18 with the date and time the parcel is checked in." Col. 6, lines 14-15. Indeed, when "the clerk successfully operates the wand 25 to acquire the bar code information, the tracking number of the parcel is displayed along with the date and time it is checked in" Col. 6, line 24-27.

The Kadaba bar code 30 thus does not identify the customer. As Kadaba does not disclose the claimed combination there is no anticipation.

Claim 4 adds further requirements to Claim 1, and is thus also not anticipated. Further, Claim 4 defines the bar code as including a “return history,” and that is also not found in Kadaba.

Reconsideration and withdrawal of the rejection of Claims 1 and 4 is respectfully requested.

Claims 2-3, §103 Rejection Under Kadaba & Diedrich & Nozaki

The Examiner rejected claims 2-3 as obvious over the combination of Kadaba, Dietrich and Nozaki. Kadaba is recognized as failing to teach or suggest that the barcode include a complete order and return history for the customer. Diedrich is cited for return tracking indicia that includes customer information and that can be in the form of a barcode. Nozaki is cited for the order history of a customer.

Claim 2 defines a bar code that includes an “order history and return history for the customer.” Nozaki refers to an “order history” but does not disclose any “return history.” Thus, even if combined, the three patents fail to teach or suggest the combination defined in Claim 2.

Claims 2 and 3 are not obvious as there is no suggestion to combine the references. The Examiner’s proffered reasons for combining isolated aspects of these three patents lacks any support in the record. The Examiner must not only explain the motivation for modifying and combining references, but must point to some concrete evidence in the record supporting the motivation to modify and the motivation to combine those references.

As an administrative tribunal, the Board clearly has expertise in the subject matter over which it exercises jurisdiction. This expertise may provide sufficient support for conclusions as to peripheral issues. With respect to core factual findings in a determination of patentability, however, **the Board cannot simply reach conclusions based on its own understanding or experience - or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings.** To hold otherwise would render the process of appellate review for substantial evidence on the record a meaningless exercise. [*In re Zurko*, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001) (emphasis added)].

The required evidence in the record to support the proffered combinations is entirely missing. The Examiner says the three references are combined “in order to provide a more informative system to the customer/merchant.” That is a nice platitude, but the record shows no need for such further information, and the general platitude provides no reason for picking these three specific patents and combining selected portions of them together to achieve the claimed combination.

Moreover, Kadaba tracks parcels for UPS, Dejaeger tracks customers in stores to activate audio-visual displays tailored to the customer, and Nozaki is a system for ordering photographs accompanied by sound. Each of these three cited patents is in a field of non-analogous art with respect to the other two cited patents. The only reason to pick and choose isolated features from any of these patents is found in the Applicant’s claims. But that is improper use of hindsight. The Examiner is urged to resist the temptation to use the claims as a roadmap to pick and choose isolated aspects from disparate references in order to improperly combine them to achieve the claimed combination.

The Examiner enumerates several advantages of combining these three disparate references, but there is no showing that the prior art did not adequately satisfy the preexisting need for these proffered advantages. There is no showing that the prior art suggested these advantages were desired or needed, and there is certainly no showing that portions of the three disparate patents should be combined to fulfill those advantages.

The burden of establishing even a *prima facie* case of obviousness has not been met. The Examiner is thus requested to reconsider, and withdraw the obviousness rejection on Claims 2 and 3.

Claims 5-6 & §103 Rejection On Combined With Hauser

Independent Claim 5 and dependent Claim 6 were rejected as obvious over Marksman in view of Hauser.

Independent Claim 5 defines “updating the customer’s order and return history.” The Examiner recognizes fails to teach or suggest this, but says Hauser does, citing

Abstract, Col. 2, lines 9-38 and Col. 3, lines 43 to Col. 6, line 17. Hauser fails to meet the claim requirement.

Hauser describes a merchandise return system in which several different stores have customers send their returned merchandise to a central return facility. Upon approval from the central return facility that the returned merchandise is not damaged, “the customer is electronically credited for the return of the merchandise.” Abstract, line 15-16. Crediting a customer’s account to balance the books is not the same as “updating the customer’s return history.” There is no “history” to update. Hauser describes a single transaction in which a debit is credited upon the return of merchandise and the financial books are then closed and done with. The next returned item for the same customer is treated the same way. Hauser does not teach or suggest tracking the return history for a customer and creating a history of returned items, and Hauser does not update that return history. Thus, even if combined, the proffered combination of patents fails to achieve the claimed combination.

Reconsideration and withdrawal of the rejection on Claims 5-6 are thus respectfully requested.

Moreover, there is no proper suggestion to combine these cited patents. The Examiner says the portions of Hauser are added “in order to provide a method and system for handling/tracking returned merchandise from a customer.” But Hauser describes a centralized return system where multiple merchants have customers return merchandise to a central facility. describes a way for dry cleaners to track garments that have been dry cleaned. A drycleaner is not going to ask customers to return unsuitable “merchandise” to a central return facility. The dry cleaner’s customers own the garments. The proffered reason for combining the references makes no sense.

As discussed above, *Zurko*, requires the Examiner to “point to some concrete evidence in the record in support of these findings” of the Examiner. *In re Zurko*, 59 USPQ2d at 1697. The Examiner is again urged to avoid the insidious temptation of using hindsight to scour the prior art for features in the claims, and then concoct reasons for combining isolated features from disparate patents in order to arrive at the claimed

combination. Reconsideration and withdrawal of the rejection on Claims 5-6 are thus respectfully requested.

Claim 7, §102 Rejection On Dejaeger

The Examiner rejected Independent Claim 7 as anticipated by Dejaeger.

Claim 7 is amended to define mailing an item requested by the customer, and providing advertising by mail. Dejaeger describes an “in store” mechanism to provide an audio-visual display on a monitor within the store. Mailing is not contemplated by Dejaeger, and not compatible with the “in store” system. There is no anticipation.

Reconsideration and withdrawal of the rejection is respectfully requested.

Claims 8-10, §103 Rejection On Dejaeger And Hauser

Claims 8-10 were initially considered obvious over Dejaeger in view of Hauser. Dejaeger admittedly lacks a package having a barcode identifying a customer. Hauser is cited to cure that deficiency.

The Examiner says it is obvious to incorporate a package including a barcode with the customer identification to the teachings of Dejaeger “in order to conveniently identify customer’s information directly from a barcode which is attached on the package.”

Hauser discloses a method for a plurality of merchants to have customers return merchandise to a central return facility. The central return facility sends the customer a package and barcode within which the returned merchandise is sent by the customer to the central return facility. Dejaeger describes a method for displaying audio-visual promotions on a monitor as a customer moves inside a store. Dejaeger has no package sent to the customer who is watching custom-selected advertising on monitors within the store. Since the customer is in the store and has not bought anything, there is nothing to return as in Dejaeger, and since the customer is in the store there is no need for the bar-coded package as in Dejaeger. There is no reason to add to Dejaeger’s display monitors a package containing a bar code with customer information on it. The proffered reason for combining the isolated portions of the patents makes doesn’t make sense.

Moreover, if as proposed by the Examiner is a barcode is affixed to the merchandise picked up by the customer in Dejaeger, then the barcode would have to contain information on all of the store's customers since there is no way to know in advance what merchandise the customer will pick up and scan. That could result in significant concerns on invasion of privacy.

The proposed combination simply makes no sense given the teachings of the two patents. There is no proper suggestion to combine isolated portions of these two patents. *In re Zurko*, 59 USPQ2d at 1697. Reconsideration and withdrawal of the rejection on Claims 8-10 is respectfully requested.

Claims 11-12, §103 Rejection On Dejaeger And Rando

Claims 10-12 were initially considered obvious over Dejaeger in view of Rando. Dejaeger admittedly lacks advertising sent in a second package that includes the customer's barcode. Rando is cited for that deficiency, via coupon 24 having a barcode thereon which is mailed to the customer.

Rando describes a point of sale scanner that scans coupons to see if they are valid. The coupons contain no information on the customer whatsoever. The portions cited by the Examiner (Col. 1, lines 13-27, Col. 5, lines 33-55) say a customer can receive the coupons various ways and that the customer bearing the coupon can redeem the coupon. Nowhere is there any suggestion that a direct mail advertiser should put specific customer information on mass-mailed coupons.

The Examiner says it is obvious to "incorporate the advertising package including a barcode as taught by Rando to the teachings of Dejaeger in order to conveniently identify customer's information directly from a barcode which is attached on the package." But in Dejaeger the customer is walking around inside the store, so there is no need to send the customer any package, let alone make a coupon and barcode and put it on the package.

There is no proper suggestion to combine isolated portions of these two patents. *In re Zurko*, 59 USPQ2d at 1697. Reconsideration and withdrawal of the rejection on Claims 8-10 is respectfully requested.

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New Claim 13 is added which tracks Claim 2, but is broader as it does not require the bar code contain a "complete" history. Further dependent claims are also added. No new matter is added.

NEW CORRESPONDENT ADDRESS

Please note that the attorney representing the applicant has changed, and direct further correspondence to the address listed below.

Respectfully submitted.
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